

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**In the Application of:** Michael Bauer et al.

**Application Serial No:** 10/531,389

**Filing Date:** September 28, 2005

**Title:** Value Document with printed areas  
Partly covered with film (as amended)

**Group Art Unit:** 1785

**Examiner:** Amakwe, Tamra L.

**Atty. Dk. No.:** 2732-168

**Confirmation No.:** 6518

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P.O. Box 1450

Alexandria, Virginia 22313-1450

**APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. § 41.37**

Sir:

The following comprises Appellants' Brief on Appeal appealing the final rejection, dated July 21, 2010, of claims 1-10 and 12-16. A Notice of Appeal was filed on October 21, 2010.

This Appeal Brief is accompanied by the required appeal fee set forth in 37 C.F.R. § 41.20(b)(2).

**I. REAL PARTY IN INTEREST**

As of the filing date of this Brief, the real party in interest is Giesecke & Devrient GmbH, the assignee of this application.

**II. RELATED APPEALS AND INTERFERENCES**

A related appeal has been made in co-owned, U.S. Patent Application No. 10/490,478. There are no other pending appeals, interferences or judicial proceedings known to Appellants, Appellants' legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

### **III. STATUS OF CLAIMS**

Claims 1-16 are pending in the application. In response to the Restriction Requirement dated August 6, 2008, claims 1-10 and 12 were elected to be prosecuted, with traverse, and claim 11 was withdrawn from consideration. New claims 13-15 were added by amendment on August 19, 2009. New claim 16 was added by amendment on April 27, 2010. The Office Action dated July 21, 2010, rejected claims 1-10 and 12-16. Appellants appeal the rejection of claims 1-10 and 12-16.

### **IV. STATUS OF AMENDMENTS**

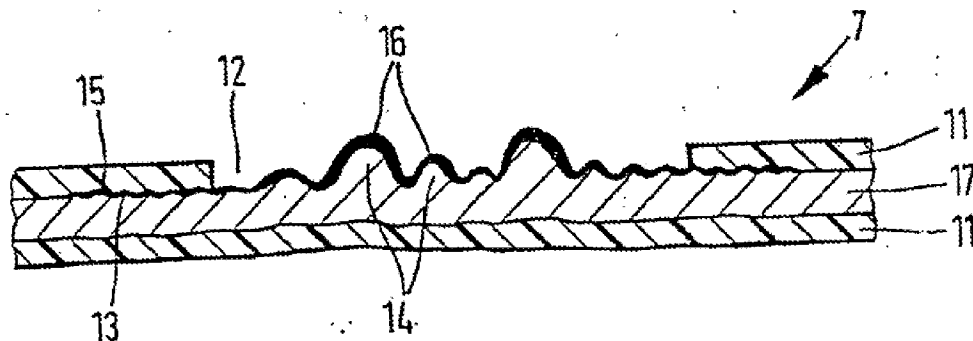
No claim amendments have been filed since the July 21, 2010, Office Action.

### **V. SUMMARY OF CLAIMED SUBJECT MATTER**

The present invention relates to a printed area on a data carrier, such as a bank note, identity card, passport, visa sticker, check form, share, certificate, postage stamp, air ticket and/or the like. Specification, page 1, lines 10-21. Specifically, the present invention relates to a data carrier having at least one printed area produced by intaglio printing and being partly covered with a foil, and to a method for producing the same. Specification, p.1, lines 10-12 and p. 3, lines 14-15. The foil is applied to a substrate (e.g., paper, plastic, plastic film laminate or coated paper) on which a printed area has been produced by intaglio printing. See Specification, page 6, line 30 through page 7, line 6. The foil 11 can be provided with a gap 12, which allows for a part of the printed area to be accessible to a tactile check, while the remaining printed area is covered by a foil. See Specification, p. 3, lines 16-30; Figures 3 (reproduced below) and 4.

The foil has a thickness between approximately 6 and 150  $\mu\text{m}$ . Specification, page 6, lines 18-20. The amount of ink and strength of the embossing can vary over the printed area resulting in relief structures in the range of approximately 5  $\mu\text{m}$  to 100  $\mu\text{m}$ , and the tactility is more pronounced in areas with more ink and stronger embossing, e.g., reference numerals 16 and 14 of Figures 3 and 4. See Specification, page 4, lines 8-20 and page 5, lines 24-25; Figures 3 and 4. Thus, the present invention has increased falsification security through combining the benefits of intaglio printing (e.g., relief structures cannot be copied through common printing process; tactile perceptibility) with the protection foil, which prevents tampering, improves fitness for circulation and prevents damage to the printed area. See Specification, page 7, lines 7-17.

**FIG. 3**



Independent claim 1, upon which claims 2-10 and 12-13 depend, defines a data carrier having a first side and a second side. See Specification, page 1, lines 10-21. The data carrier includes at least one printed area produced via intaglio printing on the first side and that has a tactile perceptibility produced by the imprinting. Specification, page 3, lines 14-15. The printed

area has a printing relief of approximately 5 to 100 microns. Specification, page 5, lines 24-25. The data carrier further includes a protective foil applied on the first side that partly covers the printed area. See Specification, page 3, lines 14-31. The protective foil is applied such that the tactile perceptibility of the intaglio printing is maintained. Id.

Independent claim 14, upon which claim 15 depends, defines a data carrier having a first side and a second side. See Specification, page 1, lines 10-21. The data carrier includes a substrate having an area containing print, and the print being printed in raised relief having a tactile perceptibility. See Specification, page 3, lines 14-15; page 5, lines 7-11; and page 7, lines 3-6. The data carrier further includes a protective foil applied to the first side of the data carrier such that a window area is maintained over at least a portion of the area containing the print so that the tactile perceptibility of the print is maintained. See Specification, page 3, lines 14-31.

Independent claim 16 defines a data carrier having a first side and a second side. See Specification, page 1, lines 10-21. The data carrier includes at least one printed area including an intaglio imprint on the first side and a tactile perceptibility. See Specification, page 3, lines 14-15 and page 5, lines 7-11. The printed area has a printing relief of approximately 5 to 100 microns. Specification, page 5, lines 24-25. The data carrier further includes a protective foil applied on the first side that partly covers the printed area, and the protective foil is applied such that the tactile perceptibility of the intaglio printing is maintained. See Specification, page 3, lines 14-31.

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

The following grounds of rejection are to be reviewed in this Appeal:

2. Whether claims 1-6, 8-10 and 12-16 are unpatentable under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,098,546 to Schell (herein "Schell") in view of Tompkin.

3. Whether claim 7 is unpatentable under 35 U.S.C. § 103(a) as obvious over Schell in view of Tompkin, and further in view of U.S. Patent No. 6,474,695 to Schneider, et al. (herein "Schneider").

4. Whether claim 2 is unpatentable under 35 U.S.C. § 103(a) as obvious over Schell in view of Tompkin, and further in view of U.S. Patent No. 4,715,623 to Roule (herein "Roule").

## **VII. ARGUMENTS**

### ***A. Applicable Law***

Nonstatutory double patenting prevents the issuance of patents with claims that are nearly identical to claims in an earlier patent. See Geneva Pharms., Inc. v. GlaxoSmithKline PLC, 349 F. 3d 1373 (Fed. Cir. 2003). The doctrine prevents an applicant from extending patent protection for an invention beyond the statutory term by claiming a slight variant of the claims of an earlier patent. See Id. A terminal disclaimer may be filed to obviate nonstatutory double patenting in a patent application. See Boehringer Ingelheim Int'l GmbH v. Barr Labs., Inc., 592 F.3d 1340 (Fed. Cir. 2010); In re Vogel, 57 C.C.P.A. 920 (C.C.P.A. 1969); 37 C.F.R. § 1.321(c); MPEP § 804.02

To determine obviousness, Title 35 requires an examination of the claimed subject matter as a whole to ascertain whether it would have been obvious at the time the invention was made. See 35 U.S.C. § 103(a). Courts must determine whether the claimed subject matter would have been obvious in the context of the Graham factors. See KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 405 (2007) (citing Graham v. John Deere Co., 383 U.S. 1, 13-14 (1966)); see also In re

Kahn, 441 F.3d 977, 985 (Fed. Cir. 2006). In *KSR*, the Supreme Court stated:

Under § 103, the scope and content of the prior are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unresolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.

KSR, 550 U.S. at 405 (quoting Graham, 383 U.S. at 17-18). The Supreme Court also observed that in making an obviousness rejection, the Examiner's analysis should be explicit. KSR, 550 U.S. at 418 ("To facilitate review, this analysis should be made explicit.") (citing In re Kahn, 441 F.3d at 988 and quoting "[Rejections cannot] be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.>").

In *KSR*, the Supreme Court observed that even in the event that the prior art demonstrates each element, "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." KSR, 550 U.S. at 418. In light of the Supreme Court's decision in *KSR*, "[i]t remains necessary to show some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." Aventis Pharma Deutschland GmbH v. Lupin, Ltd., 499 F.3d 1293, 1301 (Fed. Cir. 2007) (citing KSR, 550 U.S. at 418). In determining this reasoning, the Federal Circuit counsels "[w]e must still be careful not to allow hindsight reconstruction of references to reach the claimed invention without any explanation as to how or why the references would be combined." Innogenetics, N.V., v. Abbott Labs., 512 F.3d 1363, 1374 n.3 (Fed. Cir. 2008). Addressing motivation in the prior art protects against the use of impermissible hindsight. In re

Kahn, 441 F.3d at 986. Sources for motivation include the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. In re Rouffet, 149 F.3d at 1357.

While *KSR* eschewed a rigid teaching, suggestion, or motivation (“TSM”) test, in the wake of *KSR*, the Federal Circuit has continued to utilize a flexible TSM test and observed that “a flexible TSM test remains the primary guarantor against a non-statutory hindsight analysis.” Ortho-McNeil Pharm., Inc. v. Mylan Labs. Inc., 520 F.3d 1358, 1364 (Fed. Cir. 2008). As stated by the Federal Circuit, the flexible TSM test:

merely assures that the obviousness test proceeds on the basis of evidence – teachings, suggestions (a tellingly broad term), or motivations (an equally broad term) – that arise before the time of the invention as the statute requires.

Id. at 1365. Additionally, dependent claims are nonobvious if the independent claims from which they depend are nonobvious. Ortho-McNeil Pharm., 520 F.3d at 1365 (quoting In re Fritch, 972 F.2d 1260, 1266 (Fed. Cir. 1992)).

When determining what a prior art reference teaches, the prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

***B. Applicants request the rejection of claims 1-10 and 12-15 under the judicially created doctrine of obviousness-type double patenting over 1) claims 8-27 of U.S. Patent No. 7,357,077 in view U.S. Patent No. 6,060,143 to Tompkin, et al. (herein “Tompkin”); 2) claims 1-24 of U.S. Patent Application No. 2008/0290647 in view of Tompkin; and 3) U.S. Patent No. 7,311,043 in view of Tompkin be held in abeyance***

The Examiner rejected claims 1-10 and 12-15 under the judicially created doctrine of

obviousness-type double patenting over 1) claims 8-27 of U.S. Patent No. 7,357,077 in view of U.S. Patent No. 6,060,143 to Tompkin, et al. (herein "Tompkin"); 2) claims 1-24 of U.S. Patent Application No. 2008/0290647 in view of Tompkin; and 3) U.S. Patent No. 7,311,043 in view of Tompkin. Applicants respectfully request that this rejection be held in abeyance until claims of the present application have been found to be in condition for allowance. At that time, if the rejection still stands, Applicants will file a terminal disclaimer if appropriate.

***C. The rejection of claims 1-6, 8-10 and 12-16 under 35 U.S.C. § 103(a) as obvious over Schell in view of Tompkin was improper.***

The Examiner rejected claims 1-6, 8-10 and 12-16 under 35 U.S.C. § 103(a) based on the erroneous belief that Schell in combination with Tompkin renders them obvious. See Office Action at p. 3-6. The rejection is improper for at least the reasons that follow, and Appellants request that the Board reverse the Examiner's erroneous rejection.

A rejection under 35 U.S.C. § 103 requires a finding that "all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art." KSR International Co. v. Teleflex Inc., 550 U.S. 398, 415-416 (2007); See MPEP § 2143.02. Here, the references, taken singly or together, fail to disclose or suggest each and every feature of claims 1-6, 8-10 and 12-16.

Schell discloses a method for printing a sheet or web using intaglio technology and a device for printing the sheets or webs. Schell, Specification, col. 1, ll. 4-6. Schell discloses a method of relief printing wherein a very high contact pressure is applied between the plate

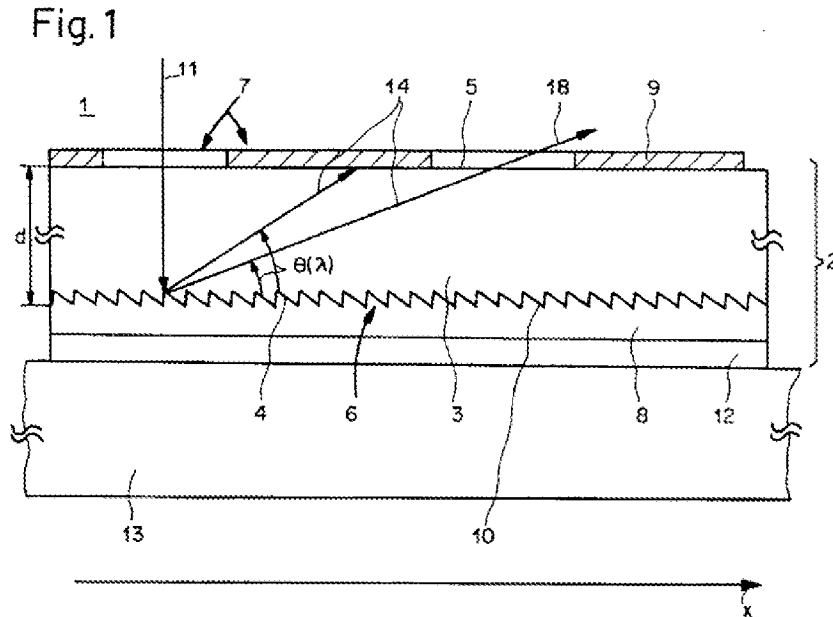


cylinder and the counter pressure cylinder, which causes the material of the paper web to be pressed into the engravings of the intaglio plate in the plate cylinder. Schell, Specification, col. 2, ll. 61-66.

The Examiner states, and Applicants agree, that Schell fails to disclose or suggest a data carrier including a protective foil applied on the first side and partly covering the printed area, wherein the protective foil is applied such that the tactile perceptibility of the intaglio printing is maintained, as recited in claim 1, upon which claims 2-6, 8-10 and 12-13 depend. Independent claims 14, upon which claim 15 depends, and 16 also recite a protective foil applied to the first side of the data carrier and partly covering the printed area such that the tactile perceptibility of the print is maintained. Therefore, Schell fails to disclose or suggest each and every element of claims 1-6, 8-10 and 12-16.

Tompkin fails to remedy the deficiencies of Schell. Tompkin discloses an optical information carrier with at least two optically effective structures which are arranged in different planes and which jointly produce a characteristic optical effect. Tompkin, col. 1, ll. 44-48. The core of the optical information carrier is formed by a carrier foil 3, and the underside 4 and top side 5 of carrier foil 3 are provided with optically effective structures 6, 7, the interplay of which produces very different optical effects. See Tompkin, col. 2, ll. 17-26; Figure 1 (reproduced below). The optically effective structures 6,7 can be formed by shaping microscopic or macroscopic relief structures in the underside and top side 4 and 5 respectively and/or by applying further layers 8, 9 to the underside 4 and the top side 5 respectively. Tompkin, col. 2, ll. 26-30; Figure 1. The gaps in the top layer 9 allow light 11 to enter the interior of the optical information carrier, and the diffracted light 18 is then allowed to issue from the optical information carrier through a gap in the top layer 9. Tompkin, col. 3, ll. 1-11; Figure 1. The top

layer 9 can be a metal layer or a dyestuff layer applied by a printing procedure, and the layer 9 has a thickness is some tens of nanometers, typically 20-70 nanometers. See Tompkin, col. 2, ll. 55-59 and col. 8, ll. 54-56.



Tompkin fails to disclose or suggest a data carrier including a protective foil applied on the first side that partly covers the printed area, wherein the protective foil is applied such that the tactile perceptibility of the intaglio printing is maintained, as recited in claim 1, upon which claims 2-6, 8-10 and 12-13 depend. The Examiner asserts that the top layer 9 of Tompkin is a protective foil. Office Action, p. 4. However, the thickness of the top layer in Tompkin is only tens of nanometers. Tompkin, col. 8, ll. 54-56. The thickness of the protective foil in the present invention is approximately 6 to 150 micrometers. Specification, page 6, lines 18-20. The protective foil of the present invention is three orders of magnitude thicker than the top layer in Tompkin. The protective layer in the present invention prevents tampering, improves fitness for

circulation and prevents damage to the printed area. *See* Specification, page 7, lines 7-17. The top layer of Tompkin is not sufficient to perform the protective function required of the protective foil in the present invention. Even if the top layer of Tompkin were applied to the surface web of Schell, the top layer would not protect the print area of Schell because the thickness of the top layer is several orders of magnitude smaller than the relief height of the intaglio imprint. Further, the optically effective structure 6 that the top layer 9 is applied to has a relief height in the order of magnitude of the wavelength of visible light, e.g., 0.5  $\mu\text{m}$ . A relief height in the order of magnitude of the wavelength of visible light has no tactile perceptibility. In Tompkin, the top layer is applied to a surface without tactile perceptibility, and, therefore, the top layer is not applied such that the tactile perceptibility of the intaglio printing is maintained, as required by claim 1 of the present invention.

Further, the top layer of Tompkin is used to produce optical effects. See Tompkin, col. 2, ll. 26-30 and col. 3, ll. 1-20. A person of ordinary skill in the art would not have applied the top layer of Tompkin to the surface of the web in Schell as a protective foil. The Examiner fails to show some articulated reasoning with some rational underpinning as to why a person of ordinary skill in the art would combine the relief structure disclosed by Schell with a top layer used to produce optical effects disclosed by Tompkin. Further, even if a skilled person would combine Schell and Tompkin, he or she would not arrive at the subject matter of claim 1 because a person of ordinary skill in the art would provide the light conductor structure of Tompkin rather than picking isolated elements, i.e., a person of ordinary skill in the art would include a transparent foil and a top layer. In such a case, the transparent carrier foil of Tompkin might then be identified with the protective foil required in claim 1, and Tompkin fails to disclose or suggest providing any gaps in the carrier foil. Tompkin even teaches away from providing gaps in the

carrier foil because any gaps would compromise the function of the disclosed light conductor structure. The structure, dimensions and purpose of the carrier foil and top layer of Tompkin is different than the structure, dimensions and purpose of the protective foil in the present invention, and a person of ordinary skill in the art would not combine Schell and Tompkin to arrive at the invention recited in claim 1.

Therefore, the combination of Schell and Tompkin fails to disclose or suggest each and every element of independent claim 1, upon which claims 2-6, 8-10 and 12-13 depend. Further, independent claims 14, upon which claim 15 depends, and 16 also recite a protective foil applied to the first side of the data carrier and partly covering the printed area such that the tactile perceptibility of the print is maintained. Therefore, the combination of Schell and Tompkin fails to disclose or suggest each and every element of claims 1-6, 8-10 and 12-16. Appellants submit that claims 1-6, 8-10 and 12-16 are patentable and request that the Board reverse the Examiner's rejection.

***D. The rejection of claim 7 under 35 U.S.C. § 103(a) as obvious over Schell in view of Tompkin in further view of Schneider was improper.***

Claim 7 depends from claim 1. As already discussed, supra, the combination of Schell and Tompkin fails to disclose or suggest each and every element of claim 1. Therefore, the combination of Schell and Tompkin fails to disclose or suggest each and every element of claim 7 for at least the foregoing reasons.

Schneider fails to remedy the deficiencies of Schell and Tompkin. Schneider relates to a security thread with characters and patterns that are readable to the naked eye and/or machine. Schneider, col. 2, ll. 40-46. Schneider fails to disclose or suggest a protective foil applied on the first side and partly covering the printed area, wherein the protective foil is applied such that the

tactile perceptibility of the intaglio printing is maintained, as recited in claim 1, upon which claim 7 depends. Therefore, the combination of Schell, Tompkin and Schneider fails to disclose or suggest each and every element of claim 7. Appellants submit that claim 7 is patentable and request that the Board reverse the Examiner's rejection.

***E. The rejection of claim 2 under 35 U.S.C. § 103(a) as obvious over Schell in view of Tompkin in further view of Roule was improper.***

Claim 2 depends from claim 1. As already discussed, supra, the combination of Schell and Tompkin fails to disclose or suggest each and every element of claim 1. Therefore, the combination of Schell and Tompkin fails to disclose or suggest each and every element of claim 2 for at least the foregoing reasons.

Roule fails to remedy the deficiencies of Schell and Tompkin. Roule relates to a method of impressing a secret pattern on a substrate by the use of an unlinked intaglio printing plate. Roule, col. 1, ll. 44-48. Roule fails to disclose or suggest a protective foil applied on the first side and partly covering the printed area, wherein the protective foil is applied such that the tactile perceptibility of the intaglio printing is maintained, as recited in claim 1, upon which claim 2 depends. Therefore, the combination of Schell, Tompkin and Roule fails to disclose or suggest each and every element of claim 2. Appellants submit that claim 2 is patentable and request that the Board reverse the Examiner's rejection.

**CONCLUSION**

For the foregoing reasons, appellants respectfully request that the Board reverse all rejections.

**AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT AND  
CONTINGENT PETITION FOR EXTENSION OF TIME**

Unless a check for the present Brief on Appeal is submitted herewith for the fee required under 37 C.F.R. § 41.20(b)(2), please charge said fee to Deposit Account No. 02-2135.

Appellants hereby petition for any extension of time which may be required to maintain the pendency of this case, and any required fee for such extension is to be charged to Deposit Account No. 02-2135.

Respectfully submitted,

Date: December 21, 2010

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VIII. CLAIMS APPENDIX

1. A data carrier having a first side and a second side, said data carrier comprising:  
  
at least one printed area produced by imprinting via intaglio printing on the first side and having a tactile perceptibility produced by the imprinting, said printed area having a printing relief of approximately 5 to 100 microns; and  
  
a protective foil applied on the first side and partly covering said printed area, wherein the protective foil is applied such that the tactile perceptibility of the intaglio printing is maintained.
2. A data carrier according to claim 1, wherein the printed area additionally comprises a blind-embossed area.
3. A data carrier according to claim 1, wherein at least one partial area of the non-covered printed area is tactilely perceptible.
4. A data carrier according to claim 1, wherein the foil has at least one gap in the area of the printed area.
5. A data carrier according to claim 1, wherein the printed area covered with the foil has a surface relief that is greater at least in certain areas in the printed area not covered with the foil than in the printed area covered with the foil.

6. A data carrier according to claim 1, wherein the data carrier is an identification document.
7. A data carrier according to claim 1, wherein the foil has holographic embossed structures.
8. A data carrier according to claim 1, wherein the foil has a thickness of less than 20  $\mu\text{m}$ .
9. A data carrier according to claim 1, wherein the printed area has a finely structured pattern.
10. A data carrier according to claim 1, wherein the printed area has a pattern which extends essentially seamlessly between the area covered with foil and the uncovered area.
11. A method for producing a data carrier having a printed area produced by intaglio printing and partly covered with a foil, comprising the following steps:
  - at least partly printing on a substrate by intaglio printing, said intaglio printing producing a printed area having a tactile perceptibility; and
  - applying a foil to the substrate so as to partly cover the area executed by intaglio printing, wherein the foil is applied such that the tactile perceptibility of the intaglio printing is maintained.
12. The data carrier of claim 9, wherein said finally structured pattern comprises guilloches.



13. The data carrier according to claim 1, wherein said foil comprises polyethylene terephthalate (PET) or thermoplastics.
14. A data carrier having a first side and a second side, said data carrier comprising:  
a substrate having an area containing print, said print being printed in raised relief ~~and~~  
having a tactile perceptibility;  
a protective foil applied to the first side of the data carrier such that a window area is maintained over at least a portion of the area containing said print so that the tactile perceptibility of said print is maintained.
15. A data carrier according to claim 14, wherein said relief of said print is approximately 5 to 100 microns.
16. A data carrier having a first side and a second side, said data carrier comprising:  
at least one printed area including an intaglio imprint on the first side and having a tactile perceptibility, said printed area having a printing relief of approximately 5 to 100 microns; and  
a protective foil applied on the first side and partly covering said printed area, wherein the protective foil is applied such that the tactile perceptibility of the intaglio printing is maintained.

IX. EVIDENCE APPENDIX

Not Applicable.

X. RELATED PROCEEDINGS APPENDIX

Not applicable.